Application Serial No. 10/595,647 Submission dated March 22, 2007

#### IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.

10/595,647

Confirmation No. 4020

Applicant

Achim Menne

Filed

STARTING UNIT

TC/A.U.

Title

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Examiner

VOI0258

Corresponding to:

Atty. Docket No. Customer No.

0832

tbd

PCT/EP2004/012700

Filed: November 10, 2004

## SUBMISSION OF INTERNATIONAL PRELIMINARY EXAMINATION REPORT

Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450

Sir:

Submitted herewith is an English translation of the International Preliminary

Examination Report.

Respectfully submitted,

John F. Hoffman

Registration No. 26,280 Attorney for Applicants

JFH/nw

**BAKER & DANIELS** 

111 East Wayne Street, Suite 800

Fort Wayne, IN 46802 Telephone: 260-424-8000 Facsimile: 260-460-1700

Enc. **IPER Translation** 

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## CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on: March 22, 2007

JOHN F. HOFFMAN, REG. NO. 26,280 Name of Registered Representative Signature 2007 March 2 Date

## PATENT COOPERATION TREATY

## **PCT**

# TRANSLATION INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

(Chapter II of the Patent Cooperation Treaty)

(PCT Article 36 and Rule 70)

| PG 0                                | 's or agent's file reference 6135WO  | nce               | FOR FURTHER A             | ACTION                      | See Form PCT/IPEA/416                  |  |  |  |
|-------------------------------------|--|-------------------|---------------------------|-----------------------------|--|--|--|--|
| International application No.       |  |                   | International filing d    | late (day/month/year)       | Priority date (day/month/year)         |  |  |  |
| PCT/EP2004/012700                   |  |                   | 10.11.200                 | )4                          | 14.11.2003                             |  |  |  |
| Internation                         | nal Patent Classification  | on (IPC) or natio | onal classification and   | 3 IPC                       |  |  |  |  |
| 1                                   | F16D33/02, F16D33/06   |                   |                           |                             |  |  |  |  |
| Applicant VOITH TURBO GMBH & CO. KG |  |                   |                           |                             |  |  |  |  |
| Į v                                 | <ol> <li>This report is the international preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36.</li> </ol>  |                   |                           |                             |  |  |  |  |
| 2. 7                                | This REPORT consists   | s of a total of   | 8                         | sheets, includin            | g this cover sheet.                    |  |  |  |
| 3. 7                                | This report is also acco   | ompanied by Al    | NNEXES, comprising        | y:                          |  |  |  |  |
|                                     | a. (sent to the  | e applicant and   | to the International B    | ureau) a total of 2         | sheets, as follows:                    |  |  |  |
|                                     | a. (sent to the applicant and to the International Bureau) a total of 2 sheets, as follows:  sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications authorized by this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions). |                   |                           |                             |  |  |  |  |
|                                     | sheets which supersede earlier sheets, but which this Authority considers contain an amendment that goes beyond the disclosure in the international application as filed, as indicated in item 4 of Box No. I and the Supplemental Box.  |                   |                           |                             |  |  |  |  |
| ,                                   | b. (sent to the  | e International I | Bureau only) a total of   | f (indicate type and numbe  | er of electronic carrier(s))           |  |  |  |
|                                     | ,  |                   | , man a ,                 | · ((                        |  |  |  |  |
|                                     | related thereto, in computer readable form only, as indicated in the Supplemental Box Relating to Sequence Listing (see Section 802 of the Administrative Instructions).   |                   |                           |                             |  |  |  |  |
| 4. 7                                | This report contains in  | dications relatir | ng to the following ite   | :ms:                        |  |  |  |  |
|                                     | Box No. I  | Basis of the      | report                    |                             |  |  |  |  |
| [                                   | Box No. II   | Priority          | •                         |                             |  |  |  |  |
| [                                   | Box No. III  | Non-establis      | shment of opinion with    | h regard to novelty, invent | tive step and industrial applicability |  |  |  |
| [                                   | Box No. IV   | Lack of unit      | y of invention            |                             |  |  |  |  |
|                                     | Box No. V  Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement   |                   |                           |                             |  |  |  |  |
|                                     | Box No. VI   | Certain docu      | uments cited              |                             |  |  |  |  |
|                                     | Box No. VII  | Certain defe      | ects in the international | l application               |  |  |  |  |
|                                     | Box No. VIII   | Certain obse      | ervations on the interna  | ational application         |  |  |  |  |
| Date of sul                         | bmission of the deman  | nd                |                           | Date of completion of th    | is connet                              |  |  |  |
| Date of San                         | June of the General  | 10                |                           | Date of completion of the   | 15 героп                               |  |  |  |
| Name and                            | mailing address of the   | e IPEA/EP         |                           | Authorized officer          |  |  |  |  |
|                                     |  |                   |                           |                             |  |  |  |  |
| Facsimile !                         | No   |                   |                           | Telephone No                |  |  |  |  |

## INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.
PCT/EP2004/012700

| Box | No. I       | Basis of the report   |   |
|-----|-------------|---|---|
| 1.  |             | n regard to the language, this report is based on the internation cated under this item.  | nal application in the language in which it was filed, unless otherwise   |
|     |             | This report is based on translations from the original language which is the language of a translation furnished for the purport.             | ge into the following language  oses of:  |
|     |             | international search (Rule 12.3 and 23.1(b))  |   |
|     |             | publication of the international application (Rule 12.4)  |   |
|     |             | international preliminary examination (Rule 55.2 and/o  | or 55.3)  |
| 2.  | recei       | a regard to the elements of the international application, this<br>iving Office in response to an invitation under Article 14 are<br>report): | report is based on (replacement sheets which have been furnished to the referred to in this report as "originally filed" and are not annexed to |
|     |             | the international application as originally filed/furnished   |   |
|     | $\boxtimes$ | the description:  |   |
|     |             | pages 1-21  | as originally filed/furnished   |
|     |             |   | received by this Authority on   |
|     |             |   | received by this Authority on   |
|     | $\boxtimes$ | the claims:   |   |
|     |             | nos6-17   | as originally filed/furnished   |
|     |             | nos.*   | as amended (together with any statement) under Article 19   |
|     |             | nos.* _1-5  | received by this Authority on 14.09.2005 with telefa  |
|     |             | nos.*   | received by this Authority on   |
|     | $\boxtimes$ | the drawings:   | -   |
|     |             | sheets 1/5-5/5  | as originally filed/furnished   |
|     |             |   | received by this Authority on   |
|     |             | sheets*   |   |
|     |             | a sequence listing and/or any related table(s) - see Suppleme   |   |
| 3.  |             | The amendments have resulted in the cancellation of:  |   |
|     |             | the description, pages  |   |
|     |             | the claims, nos.  | · · · · · · · · · · · · · · · · · · ·   |
|     |             |   |   |
|     |             |   |   |
|     |             | any table(s) related to sequence listing (specify):   |   |
| 4.  |             | This report has been established as if (some of) the amenda<br>they have been considered to go beyond the disclosure as file                  | ments annexed to this report and listed below had not been made, since ed, as indicated in the Supplemental Box (Rule 70.2(c)).                 |
|     |             | the description, pages  |   |
|     |             | the claims, nos.  |   |
|     |             | the drawings, sheets/figs   |   |
|     |             | the sequence listing (specify):   |   |
|     |             | any table(s) related to sequence listing (specify):   |   |
| *   | If ite      | m 4 applies, some or all of those sheets may be marked "supe  | rseded."  |

## INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.
PCT/EP2004/012700

| Box No. V Re                  | asoned statement                        | under A   | rticle 35(2) with regard to novelty, inventive ste | PC1/EP2004/012                | 2700  |
|-------------------------------|---|-----------|--|-------------------------------|-------|
| cit                           | ations and explan                       | ations su | pporting such statement                            | p or moustrial applicability, |       |
| 1. Statement                  |   |           |  |                               |       |
| Novelty (N)                   |   | Claims    |  |                               | YES   |
|                               |   | Claims    | 1-7  |                               | NO    |
| Inventive ste                 | p(IS)                                   | Claims    | 10   |                               | YES   |
|                               |   | Claims    | 1-9,11-17  |                               | NO    |
| Industrial applicability (IA) |   | Claims    | 1 17   |                               |       |
|                               | •                                       | Claims    | 1-1/   |                               | — YES |
|                               | - · · · · · · · · · · · · · · · · · · · |           |  |                               |       |
| 2. Citations and exp          | planations (Rule 70                     | .7)       |  |                               |       |
| 1.                            | This                                    | repo      | rt makes reference to                              | the following                 |       |
|                               | docum                                   | nents     | :  |                               |       |
|                               |   |           |  |                               |       |
|                               | D1:                                     | US-       | A-2 731 119 (BURDETT H                             | ARRY W ET AL)                 |       |
|                               |   | 17        | January 1956 (1956-01-                             | 17)                           |       |
|                               | D2:                                     | US-       | A-3 952 508 (BOPP ET A                             | L) 27 April                   |       |
|                               |   |           | 6 (1976-04-27)                                     | •                             |       |
|                               |   |           | ·  |                               |       |
| 2.                            | The r                                   | rese      | nt application does not                            | t meet the                    |       |
|                               |   |           | nts of PCT Article 33(                             |                               |       |
|                               |   |           | ct matter of claim 1 la                            |                               |       |
|                               |   |           |  | _                             |       |
|                               | MICIT                                   | II CII    | e meaning of PCT Artic                             | ie 33(2).                     |       |
|                               | D1 -12                                  |           | (1.1)  |                               |       |
|                               |   |           | ses (the reference sign                            | ns in                         |       |
|                               | parer                                   | thes      | es refer to D1):                                   |                               |       |
|                               |   |           |  |                               |       |
|                               | _                                       | _         | namic coupling                                     |                               |       |
|                               |   |           | an input that can be co                            | _                             |       |
|                               | drive                                   | (28       | ) and an output that ca                            | an be coupled                 |       |
|                               | to a                                    | driv      | e output (10);                                     |                               |       |
|                               | - hav                                   | ing       | a hydrodynamic componer                            | nt comprising                 |       |
|                               | a pri                                   | mary      | impeller (24) and a se                             | econdary                      |       |
|                               | impel                                   | ler       | (18) which together t                              | form an                       |       |

Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

operating chamber that can be filled with operating material;

- having a switchable coupling (50,52) comprising at least two coupling elements that can be operatively linked in a frictionally engaged manner directly or indirectly via transmission means, the two coupling elements being a first coupling element (50) and a second coupling element (52), each of which is coupled, at least indirectly, in a rotationally fixed manner to the input (28) and the output (10), and the coupling elements are actuated via an adjusting device (18);
- having a housing (16) that is stationary or coupled to the primary impeller (18) in a rotationally fixed manner and encloses in the axial direction at least one impeller (18) while forming at least one operating material guide channel or chamber (23);
- the adjusting device (18) of the switchable coupling (50,52) is at least indirectly coupled to the operating material supply channel or chamber (23) as a source of pressure, the operating material supply channel or chamber (23) being at least indirectly connectable to an operating material supply line;
- having means (18) for influencing the transmission behavior of the hydrodynamic component (displacement of the secondary impeller);

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Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability;

- the means comprise built-in mechanical
parts (18) that are actuatable by pressure
means, said parts acting at least indirectly
on the operating circuit adjusting itself in
the operating chamber;

- the built-in mechanical parts (18) that are actuatable by pressure means are acted upon by pressure means from the supply channel or the first operating material guide channel or chamber (23), the position, opposite the operating chamber, of the built-in mechanical parts that are actuatable by pressure means being a function of the difference in pressure between the pressure means diverted from the supply channel or from the first operating material guide channel or chamber (23) on the one hand, and the pressure inside the housing in the area of the adjusting device on the other.
- 3. Dependent claims 1-9 and 11-17 (if not according to claim 10) contain no features that, in combination with the features of any claim to which they refer, meet the PCT requirements for novelty and inventive step, because the features appear to relate to simple design measures or are already known from D1 or D2; see the corresponding text passages indicated in the search report.
- 4. The combination of features contained in claim 10 is neither known from nor rendered

## INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.
PCT/EP2004/012700

| Box No. V | Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement |
|-----------|---|
|           | obvious by the available prior art.   |
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PCT/EP2004/012700

Box No. VII Certain defects in the international application

The following defects in the form or contents of the international application have been noted:

The amendments submitted with the letter of 14 September 2005 introduce substantive matter which, contrary to the requirements of PCT Article 34(2)(b), goes beyond the disclosure of the international application as filed. The amendments are as follows:

"the means comprise built-in mechanical parts that can be actuated by pressure means in the form of separate elements that can be inserted into the operating chamber or of portions of the walls that guide the flow in the operating chamber, which parts act at least indirectly on the operating circuit that adjusts itself in the operating chamber";

These amendments were taken from the description, page 5, lines 16-21, but only a portion of the information was taken from the sentence (after the word "or"). The last two lines, in particular, are missing.

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Box No. VIII Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

- 6. The term "adjusting device" (last line of claim 1) was not previously defined (as an adjusting device for the built-in mechanical parts).
- 7. Two different elements are denoted with the same name: adjusting device (15) and adjusting device (26). For this reason claims 1 and 4-8 lack clarity.
- 8. The reference signs "56" and "62" used to refer to the intermediate chamber (claim 10) were not found in the drawings.